



JHG  
PATENT APPLICATION  
Docket No. 11080.8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Justin Douglas Marty et al.

Serial No.: 10/665,344

) Art Unit

Filed: September 20, 2003

) 3765

For: SYSTEMS AND METHODS FOR  
TRANSFORMABLE SUITS

Examiner: Tejash Patel

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that the following correspondence:

- Fee Transmittal for FY 2005 (1 page)
- Response With Terminal Disclaimer (3 pages)

is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on this 26<sup>th</sup> day of November, 2004.

  
Julie Gheem



PATENT APPLICATION  
Docket No. 11080.8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## RESPONSE WITH TERMINAL DISCLAIMER

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Response is filed in response to the Examiner's Office Action dated August 25, 2004. The Examiner will note that this Response is being timely filed as its due date falls on Thanksgiving, a federal holiday.

Double Patenting Rejections

The Examiner has presented a double patenting rejection over patent no. 6,742,225 and a provisional double patenting rejection over application no. 10/638,990. Accordingly, Applicant herewith files a Terminal Disclaimer, with the accompanying fee, to overcome these rejections. Applicant's filing of the Terminal Disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections.

Conclusion

If additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Julie Gheem, one of Applicant's attorneys of record, at (801) 323-5924.

DATED this 26th day of November, 2004.

Respectfully submitted,



Julie H. Gheem  
Attorney for Applicant  
Registration No. 47,592

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 323-5924  
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Enclosures:

-Terminal Disclaimer, Fee Transmittal

JHG

DOCS-#794370-v1-Response\_to\_OA\_of\_2004-08-25.DOC



In re application of: Justin Douglas Marty et al.  
Serial No.: 10/665,344  
Filed: September 20, 2003  
For: SYSTEMS AND METHODS FOR TRANSFORMABLE SUITS  
Examiner: Tejash Patel  
Art Unit: 3765  
Docket No.: 11080.8

#### TERMINAL DISCLAIMER

##### I. Terminal disclaimer with respect to prior patent no. 6,742,225

The owner, Z Gear, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,742,225. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

##### II. Terminal disclaimer with respect to co-pending application no. 10/638,990

The owner, Z Gear, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/638,990, filed on August 11, 2003, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

III. The fee under 37 CFR 1.20(d) for this Terminal Disclaimer is herewith included via authorization, in the enclosed Fee Transmittal, to charge the specified deposit account.

Julie Gheem  
Attorney for Applicant

12/02/2004 SSESHE1 00000173 500843 10665344

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PATENT

DEC 02 2004

Effective on 10/01/2004. Patent fees are subject to annual revision.

# FEE TRANSMITTAL

## For FY 2005

 Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$ 55.00

## Complete if Known

Application Number	<u>10/665,344</u>
Filing Date	<u>Sept. 20, 2003</u>
First Named Inventor	<u>Justin Douglas Mantz et al.</u>
Examiner Name	<u>Tejash Patel</u>
Art Unit	<u>3765</u>
Attorney Docket No.	<u>11080.8</u>

## METHOD OF PAYMENT (check all that apply)

 Check     Credit Card     Money Order Deposit Account     None

Deposit Account Number

50-0843

Deposit Account Name

The Director is hereby authorized to: (check all that apply)

- Charge fee(s) indicated below
- Charge fee(s) indicated below, except for the filing fee
- Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
- Credit any overpayments

to the above-identified deposit account.

Other (please identify): \$55 fee for filing Terminal Disclaimers under 37 CFR 1.20(d)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

## FEE CALCULATION

## 1. BASIC FILING FEE

Fee Description	Fee (\$)	Small Entity Fee (\$)	Fee Paid (\$)
Utility Filing Fee	790	395	_____
Design Filing Fee	350	175	_____
Plant Filing Fee	550	275	_____
Reissue Filing Fee	790	395	_____
Provisional Filing Fee	160	80	_____

Subtotal (1) \$ 55

## FEE CALCULATION (continued)

## 2. EXTRA CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20	18	9
Each independent claim over 3	88	44
Multiple dependent claims	300	150
For Reissues, each claim over 20 and more than in the original patent	18	9
For Reissues, each independent claim more than in the original patent	88	44

Total Claims    Extra Claims    Fee (\$)    Fee Paid (\$)

- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_  
HP = highest number of total claims paid for, if greater than 20Indep. Claims    Extra Claims    Fee (\$)    Fee Paid (\$)  
- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_  
HP = highest number of independent claims paid for, if greater than 3Multiple Dependent Claims    Fee (\$)    Fee Paid (\$)  
\_\_\_\_\_Subtotal (2) \$ 55

## 3. OTHER FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)	Fee Paid (\$)
1-month extension of time	110	55	_____
2-month extension of time	430	215	_____
3-month extension of time	980	490	_____
4-month extension of time	1,530	765	_____
5-month extension of time	2,080	1,040	_____
Information disclosure stmt. fee	180	180	_____
37 CFR 1.17(q) processing fee	50	50	_____
Non-English specification	130	130	_____
Notice of Appeal	340	170	_____
Filing a brief in support of appeal	340	170	_____
Request for oral hearing	300	150	_____
Other: _____			

Subtotal (3) \$ 55

## SUBMITTED BY

Signature

Julie Gheem

Name (Print/Type)

Registration No.  
(Attorney/Agent) 47,592Telephone (80)323-5924Date Nov. 26, 2004

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments including suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.